

REMARKS

Claims 1-12 and 14-17 are pending in the above-referenced application. Additionally, claims 1-12 and 14-17 were rejected by the Examiner under 35 U.S.C. §103 under Dedrick (U.S. Patent No. 5,724,521) in further view of Angles et al. (U.S. Patent No. 6,385,592 B1). Each of the Examiner's rejections are considered and answered with regard to the above amendments and the responsive comments below. An appendix showing the amendments to the claimed invention is included following these remarks.

Claim Rejections - 35 U.S.C. §103(a)

On page 3 of the Final Office Action, the Examiner rejected claims 1-12 and 14-17 under 35 U.S.C. §103(a) as being unpatentable over Dedrick in further view of Angles et al. Applicants request the Examiner to consider and enter the above amendments and following remarks as distinguishing over the previous rejections and placing the claims in condition for allowance. Further, applicants submit that these amendments are necessary and, based upon a telephone conversation with the Examiner on January 7, 2003, place the application in better condition for allowance or appeal.

Claim 1

Applicants submit that claim 1, as amended, is not obvious in light of the stated combination of Dedrick and Angles et al. In the Final Office Action, the Examiner rejected claim 1 stating that Dedrick discloses "...renting out a marketing object container to a first party, wherein the marketing object container is presented in a web page associated with a second party (col. 4 line 3 – col. 5 Line 4) in the context of presenting advertisers' advertisements to users over the system for a fee; selecting an attribute to be associated with the marketing object

container, wherein the first party associates the attribute with the marketing object container (col. 4 lines 16-35; col 5 lines 5-53); and sending the selected attribute to be associated with the marketing object container (col. 4 lines 16-48; col. 5 lines 5-53), in the context of associating the chosen attributes with the identified advertisements.” (paragraphs 1-3, page 3 of the Office Action). However, the Examiner stated that Dedrick does not specifically disclose sending the selected attribute to be automatically associated with the marketing object container.” (paragraph 4, page 3 of the Office Action). Subsequently, the Examiner cited the further combination of Dedrick with Angles et al. as disclosing the *automatic associating* element of Applicants’ claimed invention.

In his responsive comments, the Examiner also stated that the Applicants’ claim 1 “...discloses manually associating an attribute *with the marketing object container, and also sending the selected attribute to be automatically associated with the marketing object container*, contrary to applicant’s statements/comments.” (paragraph 3, page 21 of the Office Action). The Examiner asserted that the claimed invention discloses both automatic and manual association and the combination of Dedrick and Angles et al. renders the disclosure obvious. (paragraph 3, page 21 of the Office Action). However, Applicants submit that amended claim 1 does not recite manual association and that automatic association of a marketing attribute is not obvious in light of the cited references.

As amended, claim 1 does not recite both manual and automatic association, but instead recites sending a “selected marketing attribute to be automatically associated.” Second, Dedrick and Angles et al. do not recite *a marketing attribute* as claimed by the Applicants (emphasis added). In order to establish a prima facie showing of obviousness, the Examiner must show some suggestion or motivation, either in the references or in the knowledge generally available

to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. *See* MPEP §706.02(j).

There are at least two significant differences between the cited references and combination thereof, and the claimed invention. The claimed invention is not obvious in light of the references because neither discloses the element of "...sending the selected marketing attribute to be *automatically associated*" or the element of "*a marketing attribute*." Therefore, all of the Applicants' claim limitations are neither taught nor suggested thus failing to establish a case of obviousness.

First, Applicants submit that the cited references, individually or combined, do not disclose "...sending the selected marketing attribute to be *automatically associated*." Specifically, the claimed invention of "sending the selected marketing attribute to be *automatically associated* with the marketing object container" is not disclosed by Dedrick and, further, is novel over the HTML disclosure given in Angles et al. The Examiner conceded that "Dedrick does not specifically disclose sending the selected attribute to be automatically associated with the marketing object container." (paragraph 4, page 3 of the Office Action). Subsequently, the Examiner presented the combination of Dedrick and Angles et al. as rendering obvious the Applicants' claimed invention.

The Examiner stated that HTML, the HyperText Markup Language, is a "...standard coding convention and set of codes for attaching presentation and linking attributes to information content within documents. (HTML 2.0) is currently the primary standard used for generating Web documents. During a document authoring stage, the HTML codes (referred to as

“tags”) are embedded within the informational content of the document.” (paragraph 4, page 10 of the Office Action). Generally, HTML tags are not automatically associated, but discretely embedded into content in order to create and display web pages. (Angles et al., col. 18, lines 24-37). Further, the HTML codes of Angles et al. are placed by a content provider within the content to be displayed, implying a manual and non-automatic association. (Angles et al., col. 18, lines 35-36). Claim 1 clearly recites *automatic association* of a marketing attribute, which is distinguishable from the implicitly manual use of HTML, as described by Angles et al. Thus, the cited references do not disclose the claimed invention.

Second, HTML does not disclose *marketing attributes* which are also neither disclosed by either Dedrick or Angles et al. nor obvious. The cited references fail to disclose *marketing attributes*, as claimed by the Applicants, which are patentably distinct from program codes such as HTML. (page 15 of the specification). The distinction between “marketing attribute” and HTML is considered in claim 1 and the Applicants’ specification. Read in light of the Applicants’ specification, marketing attribute clearly does not refer to HTML. Applicants state that “a marketing object container may include program codes, such as HTML...” and set forth a distinction between HTML program codes and marketing attributes (page 15 of the specification). The specification, in the next paragraph, goes on to explain “marketing attribute” in contrast to program codes such as HTML. Significantly, claim 1 recites “...presented in a web page” (implying the use of program codes such as HTML) in the first element and “...a marketing attribute” in the second element, as distinct elements of the claimed invention. Thus, the Applicants submit that the claimed invention is not obvious in light of the cited references and combination, thus failing to teach or suggest all of the limitations in claim 1.

Thus, claim 1 is in condition for allowance or appeal. The Applicants respectfully request withdrawal of the finality of the office action and entry of the above amendments and the issuance of this application to allowance. Further, as claims 2-5 depend from claim 1, Applicants submit that claims 2-5 are also in condition for allowance for similar reasons as those stated above for claim 1.

Claim 6

As claim 6 was rejected for similar reasons as claim 1, Applicants submit that amended claim 6 is in condition for allowance, for the reasons stated above for claim 1. Further, as claims 7-12 and 14 depend from claim 6, these claims are also in condition for allowance.

Claim 15

The Examiner rejected claim 15 stating that Dedrick disclosed "...a processor configured to provide a marketing object container associated with a first party;...the processor also being configured to facilitate associating the marketing object container with a website, wherein the website is associated with a second party, in the context of presenting advertisers' advertisements to users over the system for a fee;...facilitating associating an attribute with the marketing object container...a memory coupled with the processor...." (paragraph 2, page 12 of the Office Action). Applicants' amendments render claim 15 patentably distinguishable from the cited combination of Dedrick and Angles et al. for reasons similar to those cited above for claim 1. Specifically, the processor is configured to facilitate "... *automatically* associating a *marketing* attribute with the marketing object container." The Examiner conceded that Dedrick does not disclose "automatically associating a marketing attribute." (paragraph 4, page 3 of the Office Action). For similar reasons as claim 1, the Applicants submit that claim 15 is in condition for allowance.

Claims 16-17

Claim 16 was rejected for containing "...essentially the same limitations as claim 15; therefore, the same rejection is applied." (paragraph 3, page 12 of the Office Action). As claim 16 has been amended similarly to claim 15, the Applicants submit that claim 16 is in condition for allowance or appeal. Further, as claim 17 depends from claim 16, Applicants also submit that claim 17 is in condition for allowance.

CONCLUSION

Based on the above amendments and remarks, Applicants respectfully request the entry of the above amendments and submit that, as amended, all pending claims are in condition for allowance. Applicants submit that the entry of these amendments will place the application in better condition for allowance or appeal. If the Examiner has any questions or would like to discuss this case, he is invited to contact the Applicants' undersigned representative at the number given below.

Respectfully submitted,

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APPENDIX: MARKED-UP VERSION OF CLAIMS 1, 5, 6, 9, 15, AND 16

Please amend claims 1, 5, 6, 9, 15, and 16 as follows:

1. A method of providing an electronic marketing presentation, comprising:

renting out a marketing object container to a first party, wherein the marketing object container is presented in a web page associated with a second party;

selecting, by the first party, a[n] marketing attribute[to be associated with the marketing object container, wherein the first party associates the attribute with the marketing object container]; and

sending the selected marketing attribute to be automatically associated with the marketing object container.

5. The method of claim 1, further comprising renting out a second marketing object container to the first party, wherein the second marketing object container is presented in a second web page associated [by]with a third party, and wherein the selected marketing attribute is automatically associated with the second marketing object container.

6. A method of providing an electronic marketing presentation, comprising:

providing a marketing object container associated with a first party;
associating the marketing object container with a website, wherein the website is associated with a second party; and

automatically associating a[n] marketing attribute with the marketing object container[, wherein the first party associates the marketing attribute with the marketing object container].

9. The method of claim 8, wherein associating the marketing attribute with the marketing object container also automatically associates the marketing attribute with the second marketing object container.

15. A system of providing an electronic marketing presentation, comprising:

a processor configured to provide a marketing object container associated with a first party; the processor also being configured to facilitate associating the marketing object container with a website, wherein the website is associated with a second party; and facilitating automatically associating a[n] marketing attribute with the marketing object container[, wherein the first party associates the attribute with the marketing object container]; and

a memory coupled with the processor, wherein the memory is configured to provide the processor with instructions.

16. A computer program product for providing an electronic marketing presentation, comprising:

computer code providing a marketing object container associated with a first party;

computer code associating the marketing object container with a website, wherein the website is associated with a second party;

computer code automatically associating a[n] marketing attribute with the marketing object container[, wherein the first party associates the attribute with the marketing object container]; and

a computer readable medium that stores the computer codes.